

15 JAN 1999



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6

In re Application of	:	
Shinji KAMEI	:	DECISION ON
Application No.: 08/973,564	:	
PCT No.: PCT/JP96/01622	:	PETITION
Int. Filing Date: 13 June 1996	:	
Priority Date: 16 June 1995	:	UNDER 37 CFR 1.47(b)
Attorney's Docket No.: 31425PCT/USA	:	
For: SEMICONDUCTOR DEVICE, IC CARD	:	
UTILIZING SAME AND COMMUNICATION	:	
SYSTEM	:	

This decision is in response to petitioner's renewed petition under 37 CFR 1.47(b) filed 11 December 1998 that seeks the acceptance of the application without the signature of the inventor Shinji Kamei. No additional fee is required for this renewed petition.

BACKGROUND

The decision mailed 27 October 1998 dismissed the petition under 37 CFR 1.47(b) filed 03 March 1998 because it lacked sufficient factual proof that the non-signing inventor refuses to execute the application. Specifically, the record lacked a showing that the non-signing inventor had been presented with a copy of the application papers (specification, including claims, and the oath or declaration) before refusing to sign the declaration.

On 11 December 1998, petitioner filed a renewed petition under 37 CFR 1.47(b) accompanied by a supplemental declaration of facts by Haruo Hagimori stating that he included a copy of the application papers, including the specification, claims and drawings, as well as the declaration to sign with the letter to Mr. Kamei dated 02 August 1997 and further stating that when he spoke with Mr. Kamei in a telephone conversation at his residence on 15 December 1997, Mr. Kamei said he had received the application papers enclosed with the letter of 02 August 1997, but refused to sign the papers.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

The petition filed 03 March 1998 satisfied items 1, 3, 4 and 6 above, while the renewed petition filed 11 December 1998 established that Mr. Kamei was presented with a copy of the application papers before he refused to sign and, thus, satisfies item 2 above.

However, upon further review, the papers filed 03 March 1998 do not clearly establish that Mr. Kamei assigned the instant application to Rohm Co., Ltd. Specifically, it is not clear that either of the assignments submitted by petitioner is directed to the instant application. Neither assignment identifies the instant application by U.S. application number or international application number or date of execution, as required by 37 CFR 3.21 and the title of the invention in each of the assignments is different from the title of the instant application. Therefore, further evidence is required to establish that either or both of the assignments in fact constitutes an assignment of the instant application to Rohm Co., Ltd. Alternatively, petitioner may wish to consider filing an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to Rohm Co., Ltd. The facts in support of any conclusion that a court would award title to Rohm Co., Ltd. should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

Accordingly, it would not be appropriate to grant the petition under 37 CFR 1.47 at this time.

CONCLUSION

For all of the reasons discussed above, the petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

Applicant is required to submit a declaration in compliance with 37 CFR 1.497 executed by the inventor or correct the defect noted above within a time period of **TWO (2) MONTHS** from the mail date of this decision. **THIS PERIOD FOR RESPONSE MAY BE EXTENDED UNDER 37 CFR 1.136(a). FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.**

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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